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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,561

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Alan Farer

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/520,561

Applicant(s)

FARER ET AL.

Examiner

GINA C. YU

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1617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

Receipt is acknowledged of amendment filed on December 14, 2007. Claims 1, 2-6 are pending, of which claim 5 has been withdrawn from consideration per response to restriction requirement, dated July 19, 2007. Claim rejection made under 35 U.S.C. § 102 (b) as indicated in the previous Office action, dated September 14, 2007, is withdrawn in view of further consideration and replaced with a new rejection under § 102 (b) and 103 (a). A new rejection under § 103 (a) is also made in view of the claim amendment made by applicant.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hurschmann et al. (WO 99/20230 A2, Translation).**

Hurschmann discloses a hair mascara composition comprising 8 % of stearic acid, 0.5 % of Luviskol VA 64 (vinylacetyl-vinylpyrrolidone copolymer), 0.5-1.0 % of

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carnauba wax. See Example Formulation R2. Polyvinylpyrrolidone is also taught on page 4. Active agents (pigments, perfume, etc) and an emulsifier (cetylstearyl alcohol) are also included in the composition. See instant claim 3 and 4.

The reference states, “[F] or the production of the mascara according to the inventions, the pigments, the nonionogenic synthetic polymers and the waxes are worked into a suitable water-containing carrier. Such carriers are, for example, creams, emulsions, and gels”. See p. 5, bridging par.

Although the prior art is made by adding the ingredients in water, no patentable distinctions are seen between the prior art and the claimed product. It is well settled in patent law that “[E] ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In this case, the present claim requires that the water-soluble polymer, wax, and stearic acid be separately mixed to form a stable colloidal complex before it is emulsified with the water phase. Hurschmann also reference teaches making emulsions by adding emulsifiers and mixing the ingredients to the mixture comprising the same wax, stearic acid, and water-soluble polymer; thus patentably distinct structural limitations between the final product of the Hurschmann and the present invention are not clear. Applicant discloses in specification that the polyvinyl polymer in wax produces more solid particles

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than vinyl polymer in water, and states that a structural change has occurred in the PVP/wax mixture. See [00010]. However, the final emulsion product of Hurschmann contains a mixture of PVP and wax also: the Hurschmann mascara contains the same ingredients in same amounts as the present invention.

Without a showing of unexpected result of the present invention over the Formulation R2 of the Hurschmann patent, which is the closest prior art, Examiner finds the present invention prima facie obvious.

**Claim 6 is are rejected under 35 U.S.C. 103(a) as obvious over Hurschmann as applied to claims 1, 3, and 4 as above, and further in view of McMullen (US 5800825).**

Hurschmann suggests using the wax in the amounts of 0.1-3.0 weight % but fails to teach the claimed range of 10-28 % of wax. See p. 4, first full par.

McMullen discloses a mascara composition comprising 18 % by weight of wax (beeswax and carnauba), 2.5 % of stearic acid, 7 % of PVP, emulsifier (glyceryl stearate) and water. The reference teaches that beeswax is used as binder, emulsifying agent, while carnauba is binder and hair conditioning agent.

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

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It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Hurschmann by adding more wax to the composition, as motivated by McMullen, because the latter teaches that beeswax and carnauba wax function as binders and/or hair conditioning agent. The skilled artisan would have had a reasonable expectation of successfully producing a stable mascara with enhanced stability of the composition as applied to the hair.

### ***Response to Arguments***

Applicant's arguments filed December 14, 2007 have been fully considered but they are not persuasive.

Applicant asserts that the end product of the present invention provides significantly improved moisture-resistance when compared to conventional mascara. Applicant discloses in the specification that the wax complex of beeswax/stearic acid/carnauba wax/candelilla and PVP at a ratio of 6:5:2:1:4 of the present invention is distinct from commercially available PVP/VA copolymer in terms of weights of the substrate, the wet film, the dry film before the humidity chamber, and the film after the humidity chamber. See spec., [00029-00030]. It is further stated in the specification that the wax/stearic acid/pvp complex exhibits twice stronger moisture-resistance compared to the commercial PVP/VA polymer. The specification also indicates in par. [0003] that PVP reduces the stability of the end product once it has been applied to the hair, causing the mascara being applied smeared. See [0003]. For the comparison study of the PVP crystals resulting from 4 % mixture of PVP in wax and a separate mixture of 4 % PVP in water, applicant reports the differences in physical properties in

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terms of size, color, shine, and hardness. However, there obviously should be some differences between the crystals because different components were added to PVP to produce those crystals. Unlike the applicant's comparison study, prior art teaches specifically uses the same components which applicant adds to the present invention, which results in a composition containing wax/stearic acid/ PVP just as recited by the present invention. The data in the specification does not present sufficient evidence of unexpected results of the present invention as compared to the closest prior art, Hurschmann.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/  
Primary Examiner, Art Unit 1617